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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,052	09/26/2003	Richard H. Selinfreund	VTI-114.4B(US)	7180

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EXAMINER	
ANGEBRANNDT, MARTIN J	

ART UNIT	PAPER NUMBER
1756	

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/672,052	SELINFREUND ET AL.	
	Examiner	Art Unit	
	Martin J. Angebranndt	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/20/05,2/18/05&11/5/04*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 2-6 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 2-6 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/05/04&2/18/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The response of the applicant has been read and given careful consideration. The claims are now directed to copy protected optical recording media, therefore the rejections are somewhat moot. In those cases, no response is provided as the previous rejections of the compounds themselves are obviated by the amendments to the claims.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Phenothiazine5-ium tretraiodide hydrate" should read - - Phenothiazine-5-ium tetraiodide hydrate - - .(claim 4).

In claim 3, after "push-pull change" please insert - -, which provides the copy protection and prevents readout from the recording layer, - - to clearly indicate that the recited compounds are part of the copy protection as well as their exact function.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2-6 are rejected under 35 U.S.C. 103(a) as obvious over Selinfreund et al. '922

Selinfreund et al. '922 describes the use of various dyes which are deposited on pit surfaces of optical recording media to provide copy protection to the optical recording media by acting a transient optical state change security material. [0127-0131]. Various phenothiazine

compounds are disclosed as useful for this [0083-0104]. It seems that in sections [0092-0094] that the dyes found in sections [0095-0096] were tested in this manner.

It would have been obvious to one skilled in the art to use one of the disclosed compounds, such as those disclosed in sections [0083-00104] in place of those specifically used in the formation of the transient optical state changing recording medium described in section [0092] with a reasonable expectation of forming a useful copy protected optical recording medium.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **either** Rollhaus et al. '772 **or** Smith et al. '484, in view of Strekowski et al., "A synthetic route to 3-dialkylamino)phenothiazin-5-ium salts ...", J. Heterocyclic Chem., Vol. 30(6) pp. 1693-1695 (1993).

Rollhaus et al. '772 teach the use of methylene blue (a phenothiazine) in the copy prevention of optical recording media. (see table 2 in column 8)

Smith et al. '484 teach the use of various phenothiazines including methylene blue and toluidine blue O in the copy prevention of optical recording media. (cols. 11 and 12)

Strekowski et al., "A synthetic route to 3-(dialkylamino)phenothiazin-5-ium salts ...", J. Heterocyclic Chem., Vol. 30(6) pp. 1693-1695 (1993) teaches the formation of phenothiazin-5-ium tetraiodide hydrate (page 1693/right column) and 3-(dimethylamino)phenothiazin-5-ium triiodide (page 1694/right column) . This class of compounds is known to be good dyes. (page 1693/left column)

It would have been obvious to one skilled in the art to modify the optical recording media of **either** Rollhaus et al. '772 **or** Smith et al. '484 by using other, similar, phenothiazin-5-ium

compounds known to acts as dyes, such as phenothiazin-5-ium tetraiodide hydrate or 3-(dimethylamino)phenothiazin-5-ium triiodide disclosed by Strekowski et al., "A synthetic route to 3-(dialkylamino)phenothiazin-5-ium salts ...", J. Heterocyclic Chem., Vol. 30(6) pp. 1693-1695 (1993) with a reasonable expectation of forming a useful copy protected optical recording medium which protects optical recording media based upon the oxidation of the phenothiazines by oxygen in the air.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 2-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/418898 (US prepub 2004/0004922). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application clearly embrace copy protected optical recording media using the claimed phenothiazines as these are fully encompassed by the claims of the co-pending application as evidenced by sections [0083-0104] of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebranndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Martin J Angebranndt
Primary Examiner
Art Unit 1756

04/20/2005